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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,421	01/31/2002	Tetsuo Shibuya	YOR920010126US2	6845

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EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 10/059,421	<b>Applicant(s)</b> SHIBUYA ET AL.	
	<b>Examiner</b> Cheyne D Ly	<b>Art Unit</b> 1631	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 22 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: See Continuation Sheet.
3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, second paragraph, as directed to claim 29.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-29.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: The proposed new limitations of "locates" in line 4 of claim 1, and "determines...by location" in lines 2-3 of claim 24, raise new issues that would require further consideration and/or search. Further, the limitation of claim 24 raises the issue of new matter. It is noted that claim 24, filed May 11, 2004, and the instant claim 29 recite the limitation of "locate instances of said patterns" which is different from the proposed limitation of "locates a pattern from said pattern database".

It is noted that the limitation of "determines...by location" in lines 2-3, claim 24, has not been found in the instant specification. The instant specification discloses "identify matches of a pattern in the amino acid translation" (page 5, line 21, to page 6, line 2) which is different from the proposed limitation of "determines...by location" in lines 2-3, claim 24.

Therefore, the claims amendment has not been entered.

Continuation of 5. does NOT place the application in condition for allowance because:

Claims 1-15 and 24-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is maintained with respect to claims 1-15 and 24-28, as recited in the previous office action mailed August 04, 2004.

Applicant argues that claim 1 is clear and not indefinite because the proposed claim amendments. Applicant's argument has been fully considered and found to be unpersuasive because of the non-entry of said proposed amendments.

Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. NEW MATTER REJECTION.

This rejection is maintained with respect to claim 24 as recited in the previous office action mailed August 04, 2004.

Applicant argues that the "Examiner alleges that claim 24 is not enabled by the specification". Applicant argues that the Examiner's concern has been addressed via the proposed claim amendments; therefore, claim 24 is fully enabled by the specification. Applicant's argument has been fully considered and found to be unpersuasive because the instant rejection is directed to a NEW MATTER issue, not an enablement issue. Further, the claim amendment has not been entered as discussed above.

Claims 1-14, 16-24, and 26-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory algorithm type subject matter.

This rejection is maintained with respect to claims 1-14, 16-24, and 26-29 as recited in the previous office action mailed August 04, 2004.

Applicant argues that claimed invention is directed to "a system for identifying genes" which includes at least an input device and a processor. It is re-iterated that the claimed invention is directed to a system comprising a processor and database wherein said processor discovers a pattern from said database. However, the processes for discovering patterns performed by said processor do not cause any physical alteration outside of the claimed system, as a result of the processes. A system which processes data and does not cause any physical alteration outside of the claimed system, as a result of the processes performed on said data, is considered to be non-statutory subject matter. "For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory. However, a claimed process for digitally filtering noise employing the mathematical algorithm is statutory." (MPEP § 2106 (IV)(B)(2) (b), part ii). Similar to the nonstatutory example above, the instant invention comprises electronic means for discovering patterns within a system without any physical alteration outside of said system resulted from said discovery.

It is acknowledged that the instant invention comprises an input device, however, said "input device" could reasonable be construed as a device for the electronic exchange of input files to another device in the claimed system. The electronic communication (exchange) without causing any physical alteration, outside the claimed system, resulted from the communication does not cause the claimed invention to be statutory subject matter.

It is further noted that claim 23 recites a "programmable storage medium tangibly embodying a program of machine-readable instructions executable" for performing the recited steps for identifying genes. However, said programmable storage medium comprising the process apparatus to perform the recited steps for identifying genes without causing any physical alterations outside of said "programmable storage medium resulted from accomplishing said recited steps is considered to be nonstatutory.

Applicant argues that claim 16 is directed to a method of identifying genes and the claim does not recite the term computer. It is noted that claim 16 recites limitations which have been reasonable interpreted as a computer implement method. Therefore, the instant rejection is directed to the reasonably interpreted computer implement method.

Claims 1-29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rigoutsos et al. (1998).

This rejection is maintained with respect to claims 1-29 as recited in the previous office action mailed August 04, 2004.

This rejection is maintained with respect to claims 1-29 as recited in the previous office action mailed August 04, 2004. Applicant argues "the Teiresias paper", which as been reasonably interpreted as the Rigoutsos et al. reference, does not teach the proposed limitation of "a processor...in said DNA sequence". Applicant's argument has been fully considered and found to be unpersuasive because of the non-entry of the claim amendment as discussed above.



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11/2/04